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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,688	04/04/2000	Nimesh Desai	211180370602	6165
36614 7590 11/06/2008 MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304				
EXAMINER				
GELAGAY, SHEWAYE				
ART UNIT		PAPER NUMBER		
2437				
MAIL DATE		DELIVERY MODE		
11/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/542,688

Applicant(s)

DESAI ET AL.

Examiner

SHEWAYE GELAGAY

Art Unit

2437

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No./Mail Date: _____

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on August 21, 2008. This application contains claims 19-24 and 28-38 are drawn to an invention nonelected with traverse in the reply filed on 8/21/08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
2. Claims 25 and 26 are pending.

Requirement for Information

3. Applicant's arguments filed June 30, 2008 have been considered but are not persuasive. In response to the applicant's arguments concerning the previously rejected claims, the following comments are made:

The applicant argued that "there is no motivation, express or implied, for combining the teachings of Dedrick and Achacoso because the two inventions are used for different purposes to perform different functions." The examiner respectfully disagrees. Dedrick discloses a system that has a publisher unit and servers of the WAN (i.e. external network) system that allows the server and publisher unit to transfer information (i.e. exchange information). The publisher unit and servers of the WAN system contain the interface hardware and software necessary to transfer electronic information between the components of the system. The system may have multiple client systems coupled to multiple servers. (col. 3, lines 1-36) Each client system is provided with an interface (GUI) that allows the end user to enter user profile data that includes demographic information (age, sex, income, and marital status) and

psychographic information (lifestyle and behavioral information). Dedrick further teaches that the information in personal profile is protected from access by anyone other than the individual who is associated with the information. (col. 5, line 50-col. 6, line 6) The interface provides the end user with to select certain criteria to be omitted from the compilation process. For example, the end user may select to omit details such as color preferences, income, marital status, Age, gender, etc. Alternatively, for demographic information, the user may not initially provide certain information to the personal profile database, thereby preventing its inclusion from the compilation. (col 7, lines 57-65) Which is adequate to meet the claimed limitation granting by a member, access to at least one data element associated with the member from the external network device; (i.e. the personal profile is protected from access by anyone other than the individual who is associated with the information)

Achacoso teaches a system for communicating among members of a group, comprises for each group member a device capable of transmitting and receiving information; and a central agent comprising two-way links to the peripheral device capable of receiving and transmitting information, a notice generator may push the notice, the notice comprising a summary of the information. The notice preferably comprises a summary of the information input (i.e. pushing by a member individually selected data), and a link to the information input on the central database. The notice generator may push notices via e-mail, narrowcasting, or a combination. Access to the central agent preferably requires using a password, and information inputs and notices may be encrypted. (a) pushing a notice to a member only if the member is one to whom

the associated information input was directed, and (b) transmitting an information input to a member only if the member responds to a notice. The method may further comprise allowing a person to join as a member of the group by forming a link with the person, and inviting a person to join as a member of the group and to push out group-generated information by e-mail, narrowcasting, and other such distribution methods. (i.e. allowing the other respective users to transmit information to the member) The individualized e-mail contains the content plus a mouse-clickable Web hyperlink to the message itself from the central server and/or to the entire discussion. The Web hyperlink may in itself open a videoconference, or the Web hyperlink may open a window that contains chanelized connections not only to the discussion and videoconference, but also to the schedule and address book of the group member. Both e-mail and narrowcasting can be done in multimedia, such as text, audio, video, and images. (col. 3, line 43-col. 4, line 52; col. 5, line 60-col. 6, line 16)

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one ordinary skill in the art to modify the method disclosed by Dedrick with Achacoso in order to improve the ability of groups to communicate, collaborate,

and exchange information by creating and continuously modifying information that is pushed by the group members themselves. (col. 3, lines 29-31; Achacoso) Furthermore, the examiner would like to point out that all the references cited and Applicant's invention relate to a method of controlling access to data associated with a group of members wherein the control of access is controlled by the individual member, therefore, the references are analogous art.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick U.S. Patent 5,717,923 in view of Achacoso et al. (hereinafter Achacoso) US 6,161,149.

As per claim 25:

Dedrick teaches a network including a plurality of network devices operated by a plurality of users, a method for retrieving member profile information that provides for selective real-time information exchange of member profile information between external network devices and an information exchange system comprising the steps of:

granting, by a member, access to at least one data element associated with the member from the external network devices; (col. 6, lines 4-7; col. 7, lines 57-65)

retrieving the data elements associated with the member from the external network device to the information exchange system; (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35) and

storing the data elements on the information exchange system to automate access to member profile information from the external network device. (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35)

Dedrick does not explicitly teach pushing, by the member, individually selected data elements associated with the member to other respective users; and allowing the other respective users to transmit information to the member based on the individually selected data elements. Achacoso in analogous art, however, teaches pushing, by the member, individually selected data elements associated with the member to other respective users; (col. 3, line 27-col. 4, line 57) and allowing the other respective users to transmit information to the member based on the individually selected data elements. (col. 3, line 27-col. 4, line 57) Therefore it would have been obvious to one ordinary skill in the art to modify the method disclosed by Dedrick with Achacoso in order to create

and continuously modify information that is pushed by the group member themselves.
(col. 3, lines 29-31; Achacoso)

As per claim 26:

Dedrick teaches a network including a plurality of network devices operated by a plurality of users, a method for retrieving member profile information that provides for selective real-time information exchange of member profile information between external network devices and an information exchange system comprising the steps of:

granting, by a member, access to at least one data element associated with the member from the external network devices; (col. 6, lines 4-7; col. 7, lines 57-65)

snarfing the data elements associated with the member from the external network device to an information exchange system; (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35) and

emulating the member profile on the information exchange system to automate access the external network device. (col. 3, lines 37-67; col. 5, line 50-col. 7, line 35)

Dedrick does not explicitly teach pushing, by the member, individually selected data elements associated with the member to other respective users; and allowing the other respective users to transmit information to the member based on the individually selected data elements. Achacoso in analogous art, however, teaches pushing, by the member, individually selected data elements associated with the member to other respective users; (col. 3, line 27-col. 4, line 57) and allowing the other respective users to transmit information to the member based on the individually selected data elements. (col. 3, line 27-col. 4, line 57) Therefore it would have been obvious to one ordinary skill

in the art to modify the method disclosed by Dedrick with Achacoso in order to create and continuously modify information that is pushed by the group member themselves. (col. 3, lines 29-31; Achacoso)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWAYE GELAGAY whose telephone number is (571)272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G./
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437